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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,545	11/03/2000	Peter T. Aylward	79797PAL	8710

1333 7590 07/24/2002

PATENT LEGAL STAFF
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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/24/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/705,545

Applicant(s)

Aylward et al

Examiner

RL Schilling

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 7-3-02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 22-37, 39-41 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 22-37, 39-41 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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1. The finality of the final rejection, filed January 31, 2002, is withdrawn and this application is reopened in order to make the following rejections using newly cited prior art, European Patent Publication 1003,073, Bourdelais et al. '310 and Bourdelais et al. '547.

2. Claims 22-37 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Trautweiler et al., Tingler et al. '014 and Tingler et al. '505. Trautweiler et al. (see particularly column 5, lines 7-61) discloses photographic elements with thin transparent supports which are adhered to base materials after exposure and processing. Tingler et al. '014 (see particularly column 1, lines 18-30; column 4, lines 30-65; column 5, lines 1-10; column 8, lines 8-67; Examples 1-4; column 10, lines 16-21 and lines 62-68) and Tingler et al. '505 (see particularly column 2, lines 5-33; column 10, line 5 - column 11, line 10; Examples 1-6) disclose the need for anti-static layers on opposite sides of supports from silver halide emulsion layers in order to prevent static generation from film handling and processing. Tingler et al. '505 and Tingler et al. '014 also teach the use of protective layers on the anti-static layers in order to protect the anti-static layers during processing, prevent abrasion and reduce friction. Example 1 in Tingler et al. '014 uses anti-static layer compositions and protective layer compositions substantially the same as those

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used in Example 1 of applicants' specification on the side of a transparent polyester support opposite from silver halide emulsion layers. It would be obvious to one skilled in the art to use the anti-static backing layers and protective backing layers as in Tingler et al. '014 and Tingler et al. '505 as backing layers in the photographic films of Trautweiler in order to prevent the generation of static electricity and to protect the anti-static layers during processing, prevent abrasion and reduce friction. The arguments in applicants' brief, filed July 3, 2002, have been considered but are unconvincing. The argument that there is no disclosure in Trautweiler for protective backing layers is unconvincing since the two Tingler et al. patents would motivate one skilled in the art to add anti-static layers ~~in~~ and their protective layers to the backs of the transparent polymer sheets of Trautweiler et al. in order to provide anti-static protection to the elements of Trautweiler et al. The additional secondary advantages^{+ fingerprint} of fingerprint protection does not make the instant claims patentable since combining the references for anti-static protection would still be obvious to one of ordinary skill in the art. The protective layers in the two Tingler et al. patents would inherently provide fingerprint protection^{+ by patent}, particularly since the protective layers in Example 1 of Tingler et al. '014 uses anti-static and protective layer compositions substantially the same as those used in Example 1 of applicants'

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specification. Applicants' argument that claims 24 and 27 set forth particular compositions is unconvincing since the protective layers in the two Tingler et al. patents contain binders, lubricants and fillers as set forth in instant claims 24 and 27. The working examples in the two Tingler et al. patents set forth protective layers which have the compositions set forth in instant claims 24 and 27.

2. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-37 and 39-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,626,109 in view of Tingler et al. '014 and Tingler et al. '505. Bourdelais et al., U.S. Patent 6,326,109, claims methods comprising exposure and development of photographic elements

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comprising silver halide emulsion layers on transparent supports, folding the developed elements inward and adhesively attaching to a base, i.e. the planar partitioning member, and products made by the methods. Backing layers for transparent supports of the claimed invention in U.S. Patent 6,326,109 are not set forth although they are disclosed in the specification (column 7, lines 39-53). Tingler et al. '014 (see particularly column 1, lines 18-30; column 4, lines 30-65; column 5, lines 1-10; column 8, lines 8-67; column 10, lines 16-21 and lines 62-68; Examples 1-4) and Tingler et al. '505 (see particularly column 2, lines 5-33; column 10, line 5 - column 11, line 10; Examples 1-6) disclose silver halide elements comprising protective overcoats on anti-static backing layers on transparent polymer sheets. Example 1 in Tingler et al. '014 uses anti-static layer compositions and protective layer compositions substantially the same as those used in Example 1 of applicants' specification. Since the two Tingler et al. patents disclose the need for anti-static layers on the opposite side of supports from silver halide emulsion layers in order to prevent static generation from film handling and processing, it would be obvious to one skilled in the art to use anti-static backing layers on the photographic films of the elements in the claims of U.S. Patent No. 6,326,109 in order to prevent the generation of static electricity. It would also be obvious to one skilled in the art to use the protective backing

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layers as in the two Tingler et al. patents on these anti-static layers in order to protect them during processing, prevent abrasion and reduce friction. Also, since the claimed invention in Bourdelais et al. '109 encompasses making photographic album pages, punching would be obvious to one skilled in the art for album use. It is noted that this rejection is being applied to previously allowed claims based on newly discovered prior art. Any inconvenience caused applicants is regretted.

3. Claims 22-37 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of European Patent Publication 1003073 with Tingler et al. '014 and Tingler et al. '505. The European patent publication (see particularly page 3, lines 35-51; column 5, lines 20-28; page 7, lines 32-50; page 9, lines 22-48) discloses thin photographic elements comprising thin transparent polymer supports with silver halide emulsion layers which are exposed and developed and laminated onto opaque base sheets. The European patent publication discloses that in order to transport the photographic elements during manufacturing and image processing successfully, the reduction of static caused by transport is desirable. An anti-static backing coating applied to the opposite side from the image layer is disclosed as being preferred. The two Tingler et al. patents disclose anti-static layers and protective layers therefor having excellent performing and physical and mechanical

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properties that reduce static and also resist abrasion and scratching during film transport. It would be obvious to one skilled in the art to use the particular anti-static layers and the protective layers as set forth in the two Tingler et al. patents as they called for anti-static backing layers in the European publication for their excellent film forming, physical and mechanical properties and abrasion and scratch resistance. The protective layers in the two Tingler et al. patents contain binders, lubricants and fillers as set forth in instant claims 24 and 27.

3. Claims 22-37 and 39 are rejected under 35 U.S.C. § 103(a) as being obvious over Bourdelais et al. '310 in view of Tingler et al. '014 and Tingler et al. '505.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 103(a) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application of any unclaimed subject matter prior to the effective U.S. filing date of the reference under 37 CFR 1.131. Bourdelais et al. '310 is the U.S. equivalent to

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European Patent Publication 1003,073. Bourdelais et al. '310 (see particularly column 2, lines 31-45; column 4, lines 28-55; column 9, line 65 - column 10, line 67) discloses photographic elements comprising thin transparent supports with silver halide emulsion layers which are exposed, developed and laminated onto opaque bases. In order to prevent static electricity during film handling and transport, Bourdelais et al. discloses the use of anti-static materials, preferably anti-static backing layers on their thin transparent supports. The two Tingler et al. patents disclose the use of anti-static layers and protective layers to reduce static electricity in photographic elements which have excellent mechanical and physical properties and also have scratch and abrasion resistance. It would be obvious to one skilled in the art to use the particular anti-static and protective layers of the two Tingler et al. patents as the called for anti-static backings in Bourdelais et al. in order to provide static protection with excellent mechanical and physical properties and abrasion and scratch resistance.

4. Claims 22-37 and 39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,344,310 in view of Tingler et al. '014 and Tingler et al. '505. The claims in Bourdelais et al. '310 are directed to photographic elements and methods wherein photographic elements comprising thin

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transparent polymer supports with imaging layers are, after development, laminated onto opaque bases. The claims in Bourdelais et al. '310 do not set forth anti-static backing layers on the thin transparent supports although their use is disclosed in the specification. The two Tingler et al. patents disclose the need for anti-static layers in photographic elements as set forth in the claims of Bourdelais et al. to prevent the generation of static electricity during handling and film transport. Therefore, it would be obvious to one skilled in the art to use anti-static backing layers on the photographic films of the claimed elements in U.S. Patent 6,344,310 in order to prevent the generation of static electricity during handling and processing. It would be obvious to one skilled in the art to use the protective backings as in Tingler et al. '014 and Tingler et al. '505 on these anti-static layers in order to protect them during processing, prevent abrasion and reduce friction.

5. It is noted that publication CN 125,4858 is a foreign equivalent to U.S. Patent 6,344,310 and has a publication date of May 31, 2000. A copy of CN 1254858 is not readily available; and applicants are requested to state whether May 31, 2000 is a patent date or only a publication date.

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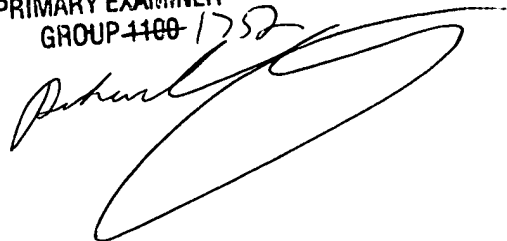
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6. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (703) 308-4403.

RLSchilling:cdc

July 22, 2002

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100-1752

A large, stylized handwritten signature in black ink, likely belonging to Richard L. Schilling, is written over the typed name and group number.